



DOCKET NO: 203852US0PCT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
JACKY JOACHIM, ET AL. : EXAMINER: GRAY, J. M.
SERIAL NO: 09/786,113 :
FILED: JUNE 4, 2001 : GROUP ART UNIT: 1774
FOR: METHOD FOR MAKING A :
FIBROUS INSULATING PRODUCT,
SIZING STUFF AND COMPOSITION

REPLY BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

The following Reply Brief is in reply to the Examiner's Answer dated June 19, 2007
(Answer).

Applicants continue to rely on the arguments made in the Appeal Brief. The following is in reply to the "Response to Argument" (Answer at 10-17). It is noted, however, that Claim 27 is no longer subject to the rejection under Ground (B).

In response to the comparative data in the specification herein and discussed in the Appeal Brief, the Examiner simply dismisses the showing as "not commensurate in scope with the claims, for example, instant claim 1, 21, 29 and 30" (Answer at 10), without any further discussion.

In reply, evidence of patentability must be commensurate in scope with only so much of the claimed subject matter that is *prima facie* obvious. See Harris A. Pitlick, *What Does "Evidence presented to rebut a prima facie of obviousness must be commensurate in scope*

with the claims to which it pertains” Mean?, 85 J. Pat. & Trademark Soc’y 257 (2003). It is Applicants’ position that none of the claimed subject matter is *prima facie* obvious and therefore, the showing is not required to be commensurate in scope with the claims. Nevertheless, the evidence is still probative of nonobviousness and patentability herein.

Ground (A)

In response to Applicants’ argument that Kennedy et al does not disclose that the monomers making up the hydrophilic latex of Kennedy et al **each** have at least one hydrophilic functional group selected from the group consisting of hydroxyl, carboxyl and ester, the Examiner finds the disclosure in Kennedy et al of polymers and copolymers formed from such monomers as “vinyl type”, “acrylic type lattices” and “vinyl acetate” meets this limitation of the claims (Answer at 11).

In reply, Kennedy et al discloses **no** polymers having **only** hydroxyl, carboxyl and/or ester groups. Rather, Kennedy et al discloses only fire resistant lattices that are halogenated and preferably also carboxylated (column 8, lines 24-26), and lists, *inter alia*, “copolymer of vinylchloride and vinylidene chloride with each other or separately with comonomers such as olefins, vinyl acetate, vinyl esters such as vinyl propionate and vinyl butyrate, as well as alkyl-substituted vinyl esters. Additionally, copolymers of vinyl chloride or vinylidene chloride with acrylic monomers such as acrylic acid, methacrylic acid, and alkyl esters thereof, may be useful in the present invention. Examples of such latex polymers are carboxylated vinylidene chloride/butadiene emulsion polymers and ethylene/vinyl chloride emulsion polymers” (column 8, lines 27-39). It is thus clear that the thermoplastic polymer of Kennedy et al necessarily includes monomers that contain no hydroxyl, carboxyl or ester group.

In response to Applicants' argument that a binder differs from a size, and the differences in preparation between the presently-claimed invention and the product of Kennedy et al demonstrates differences in the respective products, the Examiner simply finds that Kennedy et al discloses the same materials as recited in the present claims, that Kennedy et al discloses that enough binder is applied to a membrane to completely saturate fibers (column 11, lines 47-48), and therefore, a person of ordinary skill in the art "would immediately envisage some degree of uniformity in the application of the binder material to the fibers," and that Applicants have not established that the presently claimed invention "can only be defined by the process steps by which said product is made" (Answer at 12).

In reply, the present materials are not all the same, as discussed above. Moreover, no matter how much binder is present to completely saturate the fibers, the result could still not possibly be the same result obtained when a size is applied to the just formed mineral wool prior to forming a web of the sized mineral wool and then curing the size. Again, Applicants request the Board to take judicial notice of the difference between a binder, as used in Kennedy et al, and a size, as that term is used herein and as it would be understood by persons skilled in the art.

For all the above reasons, Applicants continue to maintain that this rejection be REVERSED.

Ground (B)

In response to Applicants' arguments regarding this ground of rejection, the Examiner simply cites various case law (Answer at 13-14).

In reply, Applicants have no quibble with this case law, but it is inapposite. The Examiner does not respond to Applicants' main argument that even if the mineral fibers of

Kennedy et al were prepared by the conventional processes disclosed by Kajander and/or Strauss et al, the result would still not be the presently-claimed invention.

With regard to Applicants' arguments of separate patentability of Claims 10, 11, 23 and 24, the Examiner finds that "it is not inventive to discover the optimum or workable ranges by routine experimentation" (citation omitted), and that "there is no factual evidence on this record that support the allegation that the thermoplastic polymers disclosed by Kennedy et al are inclusive of polymers having a glass transition temperature outside the terms of the present claim" (Answer at 14).

In reply, the Examiner has presented no evidence that glass transition temperature of the thermoplastic polymers used for the latex component of Kennedy et al was a known result-effective variable. Compare *In re Antonie*, 559 F.2d 618, 195 USPQ 6, 8-9 (CCPA 1977) (exceptions to rule that optimization of a result-effective variable is obvious, such as where the results of optimizing the variable are unexpectedly good or where the variable was not recognized to be result effective.) Nor is the burden on Applicants to provide evidence that the thermoplastic polymers of Kennedy et al are inclusive of polymers having a glass transition temperature outside the terms of the present claims. Rather, the burden is on the Examiner to show that the thermoplastic polymers of Kennedy et al are within the terms of the present claims. Nevertheless, whether such polymers are inside or outside is not the issue. The issue, rather, is whether one skilled in the art would consider this property as important in making Kennedy et al's fire resistant mat. As discussed above with regard to Ground (A), the main criterion in Kennedy et al is that the thermoplastic polymer be halogenated (column 8, lines 25-27).

With regard to the separate patentability of Claim 21, the Examiner responds in the same way that this issue was addressed in Ground (A) (Answer at 14-15). Applicants' reply

thereto is the same as that under Ground (A), above, which reply is incorporated by reference herein.

For all the above reasons, Applicants continue to maintain that this rejection be REVERSED.

Ground (C)

In response to Applicants' arguments under this ground of rejection, the Examiner again cites case law (Answer at 15-16). In reply, Applicants have no problem with these cases, but they are inapposite.

The Examiner finds that Lindemann et al "teaches the inclusion of silicone. Accordingly, the teachings of Lindemann would have rendered obvious the invention as claimed in present claims 9, 22, and 32" (Answer at 16).

In reply, Lindemann et al discloses the use of silicone emulsions for friction control (column 11, lines 1-2), but does not disclose water repellent agents. Nevertheless, even if water repellent agents were disclosed in Lindemann et al, the Examiner has still not rebutted Applicants' argument that one of ordinary skill in the art would not have combined Lindemann et al with the other applied prior art.

For all the above reasons, Applicants continue to maintain that this rejection be REVERSED.

Ground (D)

In response to Applicants' arguments under this ground of rejection, the Examiner finds that the fibers of WO '411 are the same type as Applicants', and that "the same fibers necessarily have the same properties" (Answer at 16).

In reply, the Examiner has still not responded to Applicants' arguments in the Appeal Brief.

The Examiner further finds "that if the evaluation of the invention as a whole is obvious, evidence or superior results does not preclude the finding of obviousness. *In re Lindell*, 155 USPQ 521 (CCPA 1967)" (Answer at 16).

In reply, this statement of the law is clearly incorrect today, if it ever was correct. See, for example, *In re Piasecki*, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984).

For all the above reasons, Applicants continue to maintain that this rejection be REVERSED.

Ground (E)

In response to Applicants' arguments under this ground of rejection, the Examiner finds that WO '437 was cited to show that mineral wool densities varied generally between 5 and 200 kg/m³ (Answer at 17).

In reply, the Examiner has still not responded to Applicants' arguments in the Appeal Brief.

The Examiner again, as in Ground (D), finds "that if the evaluation of the invention as a whole is obvious, evidence or superior results does not preclude the finding of obviousness. *In re Lindell*, 155 USPQ 521 (CCPA 1967)" (Answer at 17).

Applicants' reply is the same as made in Ground (D), above, which reply is hereby incorporated by reference.

Application No. 09/786,113
Reply Brief

For all the above reasons, Applicants continue to maintain that this rejection be
REVERSED.

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